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In re Application of	:
BENOIT, PATRICK et al	:
Serial No.: 10/802,030	:Decision on Petition
Filed : March 17, 2004	:
Attorney Docket No.: 07586.0530-01	:

This letter is in response to the Petition under 37 C.F.R. 1.144 and 1.181 filed on January 23, 2007 requesting reconsideration of the restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND

On July 19, 2006, the examiner mailed a restriction requirement in which the original claims 1-21 were divided into 16 groups.

On August 8, 2006, Applicants elected Group I (Claims 1, 2, 7, and 9-19) and SEQ ID No 3 with traverse.

On October 19, 2006 the examiner considered the traversal, made the restriction requirement FINAL and mailed to applicants a non-final Office action, in which Group I (Claims 1, 2, 7, and 9-19) drawn to SEQ ID NO 3 were searched and examined on the merits. It is noted that the Office action summary form, (PTOL-326) incorrectly stated that claims 1, 2 7 and 9-19 are allowable. Claims 1, 2, 7 and 9-19 were in fact rejected under 35 USC 101 (product of nature), 35 USC 112, first paragraph (written description) and 35 USC 102(b). The claims under examination were drawn to SEQ ID NO 3.

On January 23, 2007, applicants filed this petition to request that the Office reconsider the restriction requirement, along with a response to the Office action mailed 19 October 2006.

DISCUSSION

The petition and file history have been carefully considered. The petition sets forth several issues which will be addressed in turn.

The petition asserted that a search of the prior art related to the claimed sequences does not constitute an undue burden on the examiner. The petition cites MPEP 803.04 directed to the 1996 OG Notice, which granted a partial waiver for independent and distinct inventions. This argument has been reviewed but is not convincing. However, an OG Notice published March 27, 2007 rescinded the 1996 OG Notice that provided for a partial waiver of the requirements for restriction practice by permitting examination of a reasonable number, up to ten, independent and distinct polynucleotide molecules in a single 35 USC 111(a) or 35 USC 371 application. The Notice indicated that the standard of independence and distinctness would be applied to polynucleotide claims filed in an application under 35 USC 111(a).

The petition argues that applicants' sequences are six nested sequences, corresponding to SEQ ID NO:s: 2-7 and a further sequence, SEQ ID NO: 9, which applicants admit was known in the prior art at the time the application was filed. The polynucleotide of Group XVI (claim 21) SEQ ID NO: 2 does not appear to be a nested fragment of SEQ ID Nos 3-7. A Blast alignment of SEQ ID NO: 2 with SEQ ID NO: 3, for example, illustrated that nucleotides 1-376 of SEQ ID NO: 2 are 99% similar to nucleotides 683-1059 of SEQ ID NO: 3. The sequence alignment then appears to have a gap between the sequences, as nucleotides 427- 2052 of SEQ ID NO: 2 only align to nucleotides 1110-2739 of SEQ ID NO: 3. This region is only 98% similar. Moreover, claim 21 as currently amended requires SEQ ID NO 2 to be at least 772 residues in length. From the table below, one can see that SEQ ID No 2 only shares, at most 38 residues in common with SEQ ID Nos 3-7 and those 38 residues are not required by claim 21, as currently amended. Thus, SEQ ID NO: 2 and SEQ ID NO: 3 constitute distinct inventions Search and examination of SEQ ID NO 2 is likely to raise different issues, identity different prior art and result in different non-prior art issues than a search and examination of SEQ ID No 3-7, and vice versa. Thus the restriction requirement between Group I and Group XVI was proper.

SEQ ID NO:	CARP gene
3	-2702- +38
4	-2108- +38
5	-2011- +38
6	-1543- +38
7	-772- +38

Turning now to the restriction requirement made between Groups I-V, as shown above, combining SEQ ID NO: 3-7 into the same group as proposed by applicant is persuasive as the sequences all require residues -772 to +38 of the CARP gene. Thus SEQ ID Nos 3-7 are overlapping and within the scope of each other. A search of the overlapping sequences of SEQ ID NO 3-7 would not create a serious burden in this particular application. Therefore, the restriction requirement between Groups I-V is withdrawn.

The original restriction requirement separated Group I-V from Groups VI-X because Groups I-V are drawn to nucleic acids while Groups VI-X are drawn to expression cassettes. However, the original restriction placed the expression cassette in Groups I-V also. Moreover, the expression cassettes comprise the polynucleotides of Groups I-V and are thus not patentably distinct. Thus Groups I-V are not distinct from their corresponding Groups VI-X and the restriction requirement between Groups I-X is withdrawn.

The original restriction requirement divided claim 20 into Groups XI-XV. Claim 20 is a method of using a vector which requires one of the sequences of Groups I-X. For the same reasons that the Groups I-X have been rejoined into one invention, the restriction requirement between Groups XI-XV has been withdrawn.

The request to withdraw the restriction requirement made between the product inventions of Groups I-X and the process of using inventions Groups XI-XV is denied, as being premature, At this time not all the product claims are in condition for allowance. Should all the product claims become allowable and should all the withdrawn process claims depend from or otherwise include all the limitations of the allowable product claims, the examiner will consider rejoinder between product and process inventions, per MPEP 821.04(b).

DECISION

The petition is **GRANTED-IN-PART** for the reasons set forth above.

Rejoinder of Groups I-X is appropriate. The restriction requirement made between Groups I-X is withdrawn. Claims 1-2, 7, and 9-19 are under examination. Claims 3-6, 8 and 20 directed to SEQ ID NO: 4-7 are rejoined with the claims 1-2, 7 and 9-19 already under examination, and said claims will be examined together.

Rejoinder of Groups XI-XV into one group is appropriate. The restriction requirement made between Groups XI-XV is withdrawn.

The request to withdraw the restriction requirement between Groups (I-X) and Group XVI has been denied for reasons set forth above.

The request to withdraw the restriction requirement between product Groups (I-X) and process of using the product, Groups (XI-XV), has been denied as being premature, because the product claims are not yet in condition for allowance. Should all the product claims become allowable and should all the withdrawn process claims depend from or otherwise include all the limitations of the allowable product claims, the examiner will consider rejoinder between product and process inventions, per MPEP 821.04(b).

The application will be forwarded to the examiner for further action consistent with this decision and for the preparation of a new non-final action which addresses Group I-X as presented in the July 19, 2006 restriction requirement.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

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Director, Technology Center 1600
jb/jg